

Remarks

Claims 1-23 are pending in this application. Claims 1-11 and 13-23 have been amended. By the present amendments, Claims 1-23 remain pending. In light of the above listed amendments and the remarks below, the Applicants respectfully assert that no new matter has been added, and the application is now in condition for allowance. The Applicants respectfully solicit an indication of such an allowance.

Claim Rejections Under 35 U.S.C. § 102(e)

In the non-final Office Action, Claims 1, 2, 11, 13, and 14 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Publication No. 2004/0215560 to Amalraj et al. (hereinafter "*Amalraj*"). The Applicants respectfully assert that *Amalraj* does not teach, suggest, or motivate all claim elements of amended independent Claim 1. More specifically, *Amalraj* does not teach, suggest, or motivate, among other things, "evaluating a plurality of debit/credit combinations based at least in part on a first preference in the order of preferences to determine a best debit/credit combination." For at least this reason, *Amalraj* fails to anticipate amended independent Claims 1 and 13.

Amalraj is directed to a computer based payment system and method that allows various payment requesting sources to be coupled to various payment processors and allows for operational preferences to be established to automatically generate a payment request to as to "optimize a balance of factors associated with making a payment, such as risk and cost." (*See Amalraj*, Abstract). However, *Amalraj* fails to teach, suggest, or motivate all the claim elements of amended independent Claim 1. Amended independent Claim 1 recites claim elements that include:

determining an order of preferences, wherein the preferences include at least two of a cost of processing preference, a risk of processing preference, or a speed of processing preference;

evaluating a plurality of debit/credit combinations based at least in part on a first preference in the order of preferences to determine a best debit/credit combination, wherein each of the plurality of debit/credit combinations is capable of effecting payment; and

effecting payment in accordance with the best debit/credit combination

(See amended Claim 1). The amendments to independent Claim 1 are supported by the specification. (See Applicants' Application No. 10/631,973, e.g., paragraphs 0190-0201 and Figure 11).

The Applicants respectfully assert that *Amalraj* does not teach, suggest, or motivate the amended claim elements recited in independent Claim 1. Indeed, the Office Action of January 24, 2008 itself states that *Amalraj* fails to explicitly "teach a method wherein each of the at least two processing parameters is associated with a priority" (Office Action, page 5). Similarly, *Amalraj* does not teach or suggest determining an ordering of preferences and then determining the best debit/credit combination for processing the payment based on the first preference in the ordering. As a result, *Amalraj* does not teach, suggest, or motivate amended independent Claim 1. Further, as will be described in more detail below, *Praisner*, which was used to render several dependent claims obvious in the latest Office Action, does not teach, suggest, or motivate the functionality described in amended independent Claim 1.

For the above stated reasons, the Applicants respectfully assert that amended independent Claim 1 is not anticipated by *Amalraj* and is in condition for allowance. Further, the Applicants respectfully assert that all remarks addressed to the novelty of amended independent Claim 1 are also applicable to amended independent Claim 13. Therefore, the Applicants respectfully assert that amended independent Claim 13 is also in condition for allowance for at least the same reasons as amended independent Claim 1.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 3-10 and 15-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Amalraj* in view of U.S. Publication No. 2004/0230526 to Praisner (hereinafter "*Praisner*"). Claims 12 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Amalraj* in view of U.S. Publication No. 2002/0032651 to Embrey (hereinafter "*Embrey*"). For the below stated reasons, the Applicants respectfully assert that these rejections are now moot in light of the amendments to the Claims listed above as well as the remarks below.

The Applicants respectfully submit that, given the amendments to independent Claims 1 and 13, the rejections of dependent Claims 3-10, 12, and 15-23 are now moot. Dependent Claims 3-10, 12, and 15-23 are allowable as a matter of law as depending from either independent Claims 1 or 13, notwithstanding their independent recitation of patentable features. The Applicants also respectfully assert that the remarks above responding to the rejection under 35 U.S.C. § 102(e) by distinguishing *Amalraj* from the amended independent claims are also applicable to each of the dependent claims of the Applicants' application. Therefore, at the very least, each of the pending dependent Claims 2-12, and 14-23 are allowable as a matter of law as being dependent on allowable base claims, notwithstanding the independent recitation of patentable subject matter that may be described in one or more of the dependent claims. As a result, the Applicants respectfully assert that the rejections of the dependent claims under 35 U.S.C. § 103(a) are now moot.

Praisner Non-provisional Application Not Fully Supported by its Provisional Application

The Applicants also note that the citations to *Praisner* only constitute prior art to the Applicants' application to the extent those citations are supported by the provisional application to which *Praisner* claims priority. *Praisner* has a non-provisional application filing date of April 14, 2004, which is actually subsequent to the filing date of the Applicants' pending application on August 1, 2003. However, *Praisner* claims priority to a provisional patent filing 60/469,941 filed on May 13, 2003, which predates the filing date of the Applicants' pending application. According to MPEP 2136.03(III), the effective filing date of such a prior art published U.S. application is the filing date of the provisional applications if the provisional applications properly support the subject matter relied upon to make the rejection in compliance with 35 U.S.C. § 112 first paragraph. Therefore, the disclosures contained in the *Praisner* provisional application should be compared to the claims of the Applicants' pending application to ensure that the provisional application properly support the subject matter relied upon to make the rejection in compliance with 35 U.S.C. § 112 first paragraph. A copy of the provisional patent filing 60/469,941 was available from PAIR on the USPTO website.

The *Praisner* provisional application discloses "a method and system for pushing credit payments as buyer initiated transactions [T]he buyer communicates payment instructions to

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initiate payment of accounts payable items so that the existing credit card infrastructure can be used to make payments to merchants without an actual credit card transaction being initiated by the merchants.” (See 60/469,941, page 2, Summary of the Invention.) However, the Applicants respectfully contend that nowhere in the *Praisner* provisional application is there a teaching or suggestion of determining the ordering of preferences or determining a preference having the highest priority to ultimately determine the best debit/credit combination to process a particular payment request as discussed in amended independent Claims 1 and 13 and/or the amended dependent claims (e.g., Claims 3 and 15). Therefore, nowhere in the *Praisner* provisional application is there teaching or suggestion of the claim elements discussed in amended independent Claims 1 and 13 or their respective dependent claims. As a result, the citation to *Praisner* for the teaching of “method to prioritizing one of the payment functions . . . where at least one payment functions . . . is associated with a priority . . .” as cited on pages 5-6 of the Office Action is inappropriate.

For the above stated reasons, the Applicants respectfully assert that amended independent Claims 1 and 13 as well as their respective dependencies are not anticipated by the *Praisner* provisional application, nor are they rendered obvious by the combination of *Amalraj* and the *Praisner* provisional application. Therefore, amended independent Claims 1 and 13 and their respective dependencies are all in condition for allowance.

For at least the above stated reasons, the Applicants respectfully assert that their application is in condition for allowance and request an indication of such an allowance. If there are any issues that can be resolved by a telephone conference or an Examiner’s amendment, the Examiner is invited to call the undersigned attorney at (404) 853.8253.

Conclusion

Reconsideration of the application is requested in light of the amended claims, specification and the remarks. The Applicants believe they have responded to each matter raised by the Examiner. Allowance of the claims is respectfully solicited. It is not believed that extensions of time or additional fees are required beyond those that may otherwise be provided for in the documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. §1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 19-5029.

Respectfully submitted,

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